REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-21 are presently pending before the Office. No claims have been canceled. Applicant has amended claims 16 and 21. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed February 10, 2004 (Paper No. 11) and the references cited therein have been carefully studied by Applicant and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

Applicant must note an error entered by the Examiner, which was previously discussed with the Examiner and Applicant's representative was assured by the Examiner that she would obtain approval from her supervisor to correct the error, which can severely impact the prosecution of this application.

When applicant received a notice of abandonment for failure to respond, the undersigned representative called the Examiner and pointed out that a response was in fact

filed by express mail on April 14, 2003. A copy of the Express Mail Certificate EV208803661US and the response dated April 14, 2003 (having a 37 CFR 1.10 certification of mailing by paralegal Luann McCormick) and a separate Express Mail Certificate also signed by Ms. McCormick, as evidence that a response was in fact properly mailed on April 14, 2003.

When Applicant received the Office Action mailed February 10, 2004, it noted that the responsive communication was filed on August 18, 2003. The undersigned immediately checked the PAIRS entry made by the Examiner and it was also noted that the entry was made for August 18, 2004. This date is more than 7 months from the mailing date of the Office Action mailed on January 15, 2003.

The undersigned immediately called the Examiner and brought the error to her attention. The Examiner advised the undersigned that she would speak to her supervisors, as she had no authority to correct the entry date of the amendment, and that the error would be corrected. The Examiner agreed that the documents faxed to her on August 18, 2003 were sufficient to prove that the response was, in fact, filed on April 14, 2003.

This gross error by the Patent Office can adversely affect the application as a review SPRE can declare that the response was outside the statutory period, or large extension fees may be assessed, and the patent term adjustment is not properly made to show that the Patent Office took no action on the case from April 14, 2003 through February 10, 2004 (10 months). See attached PAIRS page and copy of Express Mail Certificate/Post card.

Applicant respectfully request that the Examiner show the Express Mail Certificate copy and the Express Mail Certifications to her Supervisors expeditiously in order to correct the file wrapper by noting that the response was properly filed on April 14, 2003.

Relying on 35 U.S.C. §112, second paragraph, the Office has rejected the subject matter of claims 16 and 21 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses the rejection and requests reconsideration.

Applicant submits that claims 16 and 21 do define the legal metes and bounds of the invention. It is not the role of the claims to enable one skilled in the art to reproduce the invention but rather to define, for those skilled in the art the legal metes and bounds of the invention. Nevertheless, in order to advance the case to allowance, claims 16 and 21 have been amended to clarify the claim limitation issues raised by the Examiner.

It is respectfully submitted that claims 16 and 21 fully comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejection is respectfully requested.

Relying on 35 U.S.C. §102(b), the Examiner has rejected the subject matter of claims 1-21 as being anticipated by WO 97/36497, which is a PCT application that takes priority to a US application, which in turn was a continuation-in-part of US 5,554,645 patent cited by the Examiner in the previous Office Action. Applicant respectfully traverses the rejection and requests reconsideration.

Applicant respectfully submits that it is important to note that, historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

The '497 publication fails this test. The '497 publication teaches procyanidin(s) extracted from cocoa and discloses its structure. However, the cited reference does not mention structural units nor component ratio of the procyanidin structure. On the other hand, the present application clearly describes the component ratio of catechin to epicatechin in polyphenols extracted from buck wheat seeds in the specification.

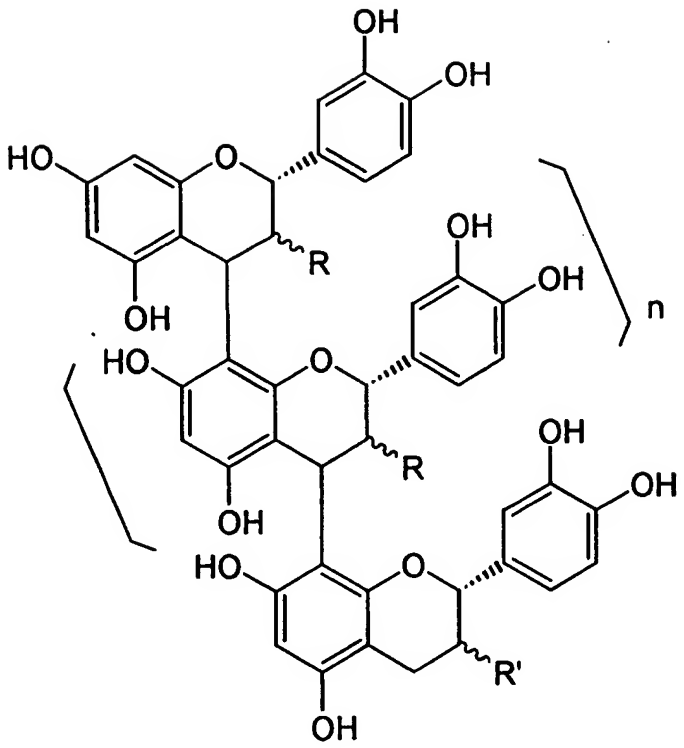
Catechin and epicatechin are stereoisomers, which have physical properties and physiological activities different from each other. Therefore, if the component ratio of catechin to epicatechin in the procyanidin of the '497 publication is different from that of the composition of the present invention, naturally, there shall be differences in the physical property and physiological property between the compositions of the two inventions (the present invention and the disclosed invention in the '497 publication).

With respect to the procyanidin of the '497 publication, only epicatechin is illustrated (in Fig. 3), and the reference is silent on the ratio of catechin to epicatechin. In fact, the reference does not present any information indicating the ratio.

With respect to the monomer compound, the '497 publication teaches the content ratio of catechin to epicatechin, 1.6% (catechin) to 38.2% (epicatechin) as disclosed in Table 4, and B-2 and B-5 dimers also comprises epicatechin. That is, the procyanidin extracted from cocoa mainly contains epicatechin in an amount larger than that of catechin.

On the other hand, the present invention discloses in detail data about the structural unit of the polyphenol polymer examined by the thiolysis method, as further described in Test 7 starting at page 25 of the specification. The results are analyzed on page 27. The formula

upper terminal



n = 0 to 7

~~R : ····OH, —OH
(2:1)

~~R' : ····OH, —OH
(1:2)

n = 2to 7

lower terminal

representing a procyanidin oligomer , indicates that the ratio of catechin to epicatechin in the upper terminal and middle is 2 to 1, and 1 to 2 in the lower terminal.

Accordingly, the total ratio of catechin to epicatechin in the polycyanidin oligomer is represented by (2n + 3) : (n + 3). With the epicatechin ratio number being highest (n = 2), the ratio of catechin to epicatechin is 7 : 5, and therefore the content of epicatechin never exceeds that of catechin in the present invention.

Accordingly, each and every element of Applicant's claims have not been taught in that single reference. In other words, the rejected claims do not read literally on any single item of prior art because the cited reference does not teach, disclose or suggest the present invention as claimed. Accordingly, Applicant respectfully submits that claims 1-20 have not been anticipated by the '497 publication under 35 U.S.C. §102(b), and respectfully requests that such rejection be withdrawn.

Relying on 35 U.S.C. §103(a), the Examiner has rejected the subject matter of claim 21 as obvious over the '497 publication in view of U.S. Patent No. 5,232,942. Applicant respectfully traverses the rejection and requests reconsideration.

It is evident that Applicant's invention is decidedly different from the teachings of the '497 publication for the reasons stated above, which are incorporated by reference for this 103(a) rejection. Further, the invention of the '942 patent, which is drawn to a low molecular weight compound, does not suggest the effects of the present invention. Accordingly, the Examiner has not established a prima facie case of obviousness.

The Office has used the claimed invention as a reference against itself as if it had preceded itself in time. Legal authority invalidates such an analytical or reverse engineering approach to patent examination. It is not Applicant's burden to refute the Office's position that it would have been obvious to one of ordinary skill in this art at the time this invention was made to arrive at the present invention in view of the combination of the cited references. It is the burden of the Office to show some teaching or suggestion in the reference to support this allegation. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d at 1051, 5 U.S.P.Q.2d at 1438-39 (Fed. Cir. 1988).

A finding by the Office that a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made based merely upon finding similar elements in a prior art reference would be "contrary to statute and would defeat the congressional purpose in enacting Title 35." Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q.2d 1593 at 1605 (Fed. Cir. 1987). Accordingly, Applicant respectfully submits that claim 21 is are patentable over the cited patents under 35 U.S.C. §103(a). Withdrawal of the rejection is respectfully requested.

CONCLUSION

Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be appreciated.

Very respectfully,

Dated: 6/23/04

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United States Patent and Trademark Office

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PATENT APPLICATION INFORMATION RETRIEVAL

Search results for application number:10/045,972			
Application Number:	10/045,972	Customer Number:	24040
Filing or 371(c) Date:	02-28-2002	Status:	Non Final Action Maile
Application Type:	Utility	Status Date:	02-10-2004
Examiner Name:	COE, SUSAN D	Location:	TC 1600 CENTRAL FIL OVERFLOW - FRANC(
Group Art Unit:	1654	Location Date:	04-10-2004
Confirmation Number:	3682	Earliest Publication No:	US 2003-0054057 A1
Attorney Docket Number:	1617.22B	Earliest Publication Date:	03-20-2003
Class/ Sub-Class:	424/776	Patent Number:	-
First Named Inventor:	Ken-ichi Kosuna, Sapporo-shi, (JP)	Issue Date of Patent:	-
Title Of Invention:	Composition for the treatment of symptoms and conditions associated with aging		

Select Search Option

Continuity Data
Publication Review
Published Documents

Search

File History

Number	Date	Contents Description
25	02-24-2004	Mail Miscellaneous Communication to Applicant
24	02-23-2004	Miscellaneous Communication to Applicant - No Action Count
23	02-10-2004	Mail Non-Final Rejection
22	02-09-2004	Non-Final Rejection
21	11-26-2003	Date Forwarded to Examiner
20	08-18-2003	Response after Non-Final Action
19	11-28-2003	Mail Notice of Rescinded Abandonment
18	11-26-2003	Notice of Rescinded Abandonment in TCs
17	08-12-2003	Mail Abandonment for Failure to Respond to Office Action
16	08-11-2003	Abandonment for Failure to Respond to Office Action
15	01-15-2003	Mail Non-Final Rejection
14	01-13-2003	Non-Final Rejection
13	10-31-2002	Case Docketed to Examiner in GAU
12	07-01-2002	Application Dispatched from OIPE
11	07-01-2002	Application Is Now Complete
10	02-28-2002	Additional Application Filing Fees

No!

04-04-2003

JUN 30 2004

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We hereby acknowledge receipt of the following:

- Response After Non-Final Office Action
- Amendment Transmittal fee sheet
- Express Mail Certificate and post card

Applicant: Ken-ichi KOSUNA
Serial No.: 10/045,972
Date Filed: 1/11/2002
Title: COMPOSITION FOR THE TREATMENT OF SYMPTOMS AND CONDITIONS ASSOCIATED WITH AGING

File No.: 1617.22B
LA: LM1

Express Mail: EV 208803661 US **Mailed: 14 April 2003**